

BS00099

U.S. Application No. 09/709,038 Examiner LEZAK, Arrienne, Art Unit 2143
Response to April 28, 2006 Office Action

REMARKS

In response to the Office Action dated April 28, 2006, the Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over *Gudjonsson* and *Armstrong*, whether considered alone or in combination.

Claims 1, 3-4, 6-12, 14-29, and 31-47 are pending in this application.

The United States Patent and Trademark Office (the "Office") rejected claims 23 and 34 under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. Claim 4 was also rejected under 35 U.S.C. § 112, second paragraph, for improper antecedent basis. Claims 1, 3-4, 6-12, 14-29, and 31-47 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,564,261 to Gudjonsson *et al.* in view of U.S. Patent 6,807,423 to Armstrong.

As the Assignee shows, however, the pending claims are fully enabled and distinguish over the proposed combination of *Gudjonsson* and *Armstrong*.

Interview

Examiner Lezak, please note that this response includes an Interview Request Form. The Assignee made several unsuccessful attempts to informally conduct a telephone interview. Should Examiner Lezak believe that an interview would be productive in light of this response, the Assignee would be grateful for an opportunity to meet/speak with the Examiner.

Summary of Arguments for Patentability

The present invention is fundamentally different from *Gudjonsson*. As the following paragraphs will explain, *Gudjonsson* provides the recipient's "online status" as a single icon that

BS00099

U.S. Application No. 09/709,038 Examiner LEZAK, Arrienne, Art Unit 2143
Response to April 28, 2006 Office Action

simply represents whether the recipient is logged in. The sender in *Gudjonsson* then selects what type of communication (e.g., page, text chat, or voice chat) is desired. *Gudjonsson* then sends an invitation for that type of communication to a "routing service." This routing service completely arranges the communication, regardless of the device being used by the recipient. *Gudjonsson's* sender does not need to know the recipient's presence — that is, whether the recipient is currently available via computer, pager, or mobile phone." *Gudjonsson's* "routing service" does not implicitly involve the exchange of network addresses, such as IP number or phone number. *Gudjonsson* "hides the messy details on how to locate and reach a given person/user at any given time."

The pending claims describe a completely different invention. Independent claim 37, for example, retrieves presence information for the recipient indicating the recipient's presence at a plurality of addresses. *Gudjonsson*, in contradistinction, only determines whether the recipient is online or not. The present invention then presents the recipient's presence information to the sender, and the presence information indicates the recipient's presence at a plurality of contact addresses. The sender's communication is then received, and the communication indicates a contact address selected by the sender to which the communication is sent. *Gudjonsson's* "routing service," again in contradistinction, does not involve the exchange of network addresses. Independent claim 37 also sends the communication to a destination, wherein the destination of the communication is the contact address selected by the sender. Again, *Gudjonsson's* "routing service" does not permit the sender to select a destination contact address.

Gudjonsson, then, cannot be used to obviate the claims. *Gudjonsson's* "routing service" completely arranges a given type of communication between the sender and recipient. The pending claims, in patentable distinction, present the recipient's presence information at a plurality of contact addresses and the sender selects a destination contact address for the communication. Because *Gudjonsson's* principle of operation must be drastically changed, *Gudjonsson* teaches away and cannot support an obvious rejection of the pending claims.

BS00099

U.S. Application No. 09/709,038 Examiner LEZAK, Arrienne, Art Unit 2143
Response to April 28, 2006 Office Action

Extension of Time

Examiner Lezak, please note this response includes an extension of time. This response includes a petition to the Commissioner for a three month extension of time from July 28, 2006 to October 28, 2006. The 37 C.F.R. § 1.17 (a)(3) large entity fee accompanies this petition.

Rejection of Claims under 35 U.S.C. § 112

The Office rejected claims 23 and 34 under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement. While the Assignee believes that claims 23 and 34 are fully enabled, claims 23 and 34 have been amended to clarify the Examiner's uncertainties. Examiner Lezak states that she is "unsure where within the process" this notification is received. Claim 23 is thus amended to indicate "*wherein the input that receives the presence information receives a notification that the contact address is active.*" Claim 34 is similarly amended. The Assignee thus respectfully asserts that claims 23 and 34 fully comply with the enablement requirement.

Claim 4 was also rejected for improper antecedent basis. Claim 4 has been amended to recite "*wherein retrieving the presence information comprises retrieving presence information for a plurality of addresses that represent at least one of different types of communications and different types of contact devices.*" The Assignee thus respectfully asserts that claim 4 fully complies with the patent laws, and Examiner Lezak is thanked for her keen eye.

Rejection of Claims under 35 U.S.C. § 103 (a)

The Office rejects claims 1, 3-4, 6-12, 14-29, and 31-47 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,564,261 to Gudjonsson *et al.* in view of U.S. Patent 6,807,423 to Armstrong. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3)

BS00099

U.S. Application No. 09/709,038 Examiner LEZAK, Arrienne, Art Unit 2143
Response to April 28, 2006 Office Action

all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

1. **Because *Gudjonsson* "Teaches Away," the Proposed Combination of *Gudjonsson* and *Armstrong* Cannot Support a *Prima Facie* Case for Obviousness**

Gudjonsson "teaches away" from the proposed combination. "A reference that 'teaches away' from the claimed invention is a significant factor" when determining obviousness. See M.P.E.P. at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at § 2141.02; see also *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "It is improper to combine references where the references teach away from their combination." M.P.E.P. at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. See M.P.E.P. at § 2143.01.

The proposed combination of *Gudjonsson* and *Armstrong* requires an impermissible change to *Gudjonsson*'s principle of operation. Examiner Lezak attempts to combine *Gudjonsson*'s "routing service" with *Armstrong*'s "personal communications portal." This proposed combination, however, impermissibly changes *Gudjonsson*'s principle of operation. *Gudjonsson* utilizes a "routing service" that "arranges for communication ... between users regardless of the client device being used by the called user." *Gudjonsson* at column 3, lines 51-58 (emphasis added). The "initiating user need not know whether the other user is currently online via his/her PC or may instead be reached via pager or mobile phone." *Gudjonsson* at column 3, lines 58-63 (emphasis added). This routing service "hides the messy details on how to locate and reach a given person/user at any given time." *Gudjonsson* at column 13, lines 49-50 (emphasis added).

BS00099

U.S. Application No. 09/709,038 Examiner LEZAK, Arrienne, Art Unit 2143
Response to April 28, 2006 Office Action

Gudjonsson must, therefore, “teach away.” The only way for *Gudjonsson* and *Armstrong* to “[present] the second user’s presence information ... indicating the second user’s presence at the plurality of contact devices,” as independent claim 1 recites, is to eliminate principle operating aspects of *Gudjonsson*’s “routing service.” Because *Gudjonsson* utilizes this “routing service,” the combined teaching of *Gudjonsson* and *Armstrong* has no need to “indicat[e] the second user’s presence at the plurality of contact devices.” *Gudjonsson*, in contradistinction, only provides “the online status of other users.” U. S. Patent 6,564,261 to *Gudjonsson et al.* at column 11, lines 46-51. “This status reflects whether a given user is currently logged in the system or not, thus giving information whether that user is immediately reachable.” *Id.* at column 11, lines 51-54. FIG. 8 of *Gudjonsson* further illustrates this “online status” as a single icon that simply represents whether a particular user is logged in. The proposed combination of *Gudjonsson* and *Armstrong*, then, cannot provide “presence information indicating the second user’s presence at the plurality of contact devices” without changing, or even eliminating, *Gudjonsson*’s principle of operation. Examiner Lezak is thus respectfully requested to remove the § 103 rejections.

2. Because *Gudjonsson* “Teaches Away” from Independent Claims 12, 24, 37 and 42, the Proposed Combination of *Gudjonsson* and *Armstrong* Cannot Support a *Prima Facie* Case for Obviousness

The proposed combination of *Gudjonsson* and *Armstrong* also “teaches away” from claims 12, 14-29, and 31-47. Independent claims 12, 24, 37, and 43 all recite features for selecting a “contact address” to which the communication is destined. Independent claim 12, for example, recites “the processor receiving a selection from the sender that selects a contact address to which the communication is addressed, and the processor initiating the communication to a destination, wherein the destination of the communication is the contact address selected by the sender” (emphasis added). The proposed combination of *Gudjonsson* and *Armstrong*, in contradistinction, utilizes a “routing service” so that “no network addresses need to be exchanged between the users.” U. S. Patent 6,564,261 to *Gudjonsson et al.* at column 3, lines 29-31 (emphasis added). This routing service “arranges for communication ...

BS00099

U.S. Application No. 09/709,038 Examiner LEZAK, Arrienne, Art Unit 2143
Response to April 28, 2006 Office Action

between users regardless of the client device being used by the called user.” *Gudjonsson* at column 3, lines 51-58 (emphasis added). The “initiating user need not know whether the other user is currently online via his/her PC or may instead be reached via pager or mobile phone.” *Gudjonsson* at column 3, lines 58-63 (emphasis added). This routing service “hides the messy details on how to locate and reach a given person/user at any given time.” *Gudjonsson* at column 13, lines 49-50 (emphasis added).

The proposed combination of *Gudjonsson* and *Armstrong* “teaches away” from claims 12, 14-29, and 31-47. Because *Gudjonsson* and *Armstrong* utilizes this “routing service,” *Gudjonsson* and *Armstrong* cannot “receiv[e] a selection from the sender that selects a contact address to which the communication is addressed, and ... initiat[e] the communication to a destination, wherein the destination of the communication is the contact address selected by the sender.” The only way for the proposed combination of *Gudjonsson* and *Armstrong* to obviate these claimed features is to impermissibly alter, or even eliminate, *Gudjonsson*’s principle of operation. Because such changes are not permissible, *Gudjonsson* cannot support a *prima facie* case. Examiner Lezak is thus respectfully requested to remove the § 103 rejections.

3. The Proposed Combination of *Gudjonsson* and *Armstrong* “Teaches Away” from Other Claimed Features

Gudjonsson and *Armstrong* “teach away” from other aspects of the proposed combination. The proposed combination of *Gudjonsson* and *Armstrong* only permits a sender to select a communications type. Independent claims 12, 24, 37, and 43, however, recite features for selecting a “contact address” to which the communication is destined. Independent claim 24, for example, recites “receiving the communication from the sender, wherein the communication indicates a contact address selected by the sender to which the communication is sent” (emphasis added). That communication is sent “to a destination, wherein the destination of the communication is the contact address selected by the sender” (emphasis added). The only way for *Gudjonsson* and *Armstrong* to obviate these claimed features is to impermissibly alter, or even eliminate, *Gudjonsson*’s principle of operation.

BS00099

U.S. Application No. 09/709,038 Examiner LEZAK, Arrienne, Art Unit 2143
Response to April 28, 2006 Office Action

Gudjonsson provides an explanation. An invitation is sent "from one user 7 to another to join him/her in some given type of communication". U. S. Patent 6,564,261 to *Gudjonsson et al.* at column 9, lines 8-10 (emphasis added). "When a user 7 wishes to establish a communication with another user, he/she will invoke some function within his/her client 11, requesting the client to send an invitation of a given type to some selected user." *Id.* at column 9, lines 14-17 (emphasis added). "The session negotiation does not implicitly involve the exchange of user's network addresses, such as IP number or phone number." *Id.* at column 10, lines 28-30 (emphasis added). "There is no limitation on what kind of invitations can be sent." *Id.* at column 13, lines 5-6. "A sending user 7 is provided with at least a few elementary types of invitations." *Id.* at column 13, lines 5-6 (emphasis added). "Referring to FIG. 9, these elementary types include the following: 1) Pages: these consist of short text messages (they are the most simple type of invitations, although they do not imply an acknowledgement from the receiving end; 2) Text Chat: these invitations can establish a real-time text chat session between the users; 3) Voice Chat: these invitations can establish a real-time voice session between the users; and 4) Web Conference: these invitation allow users to share navigation on the Web, such that the Web navigation of one user is reflected on the other user's browser." U. S. Patent 6,564,261 to *Gudjonsson et al.* at column 13, lines 9-18 (emphasis added).

Gudjonsson and *Armstrong*, then, "teach away" from claims 12, 14-29, and 31-47. Independent claims 12, 24, 37, and 43 all recite features for selecting a "contact address" to which the communication is destined. *Gudjonsson* and *Armstrong*, however, only permit a sender to select a communications type. The only way for the proposed combination of *Gudjonsson* and *Armstrong* to obviate these claimed features is to alter, or even eliminate, *Gudjonsson's* principle of operation. Because such changes are not permissible, *Gudjonsson* cannot support a *prima facie* case. Examiner Lezak is thus respectfully requested to remove the § 103 rejections.

BS00099

U.S. Application No. 09/709,038 Examiner LEZAK, Arrienne, Art Unit 2143
Response to April 28, 2006 Office Action

4. The Textual Evidence Does Not Support Examiner Lezak's Interpretation of *Gudjonsson*

The Assignee must, very respectfully, disagree with the Examiner's interpretation. Examiner Lezak asserts that *Gudjonsson's* "routing service" is "completely optional," and this interpretation is based on a single sentence in *Gudjonsson* ("Basic services which may be provided within each cluster, include, for example: ... 3) routing service, that allows users to send requests (i.e., invitations) for communication sessions to other users"). U. S. Patent 6,564,261 to *Gudjonsson et al.* at column 3, lines 1-13 (emphasis added). *Gudjonsson* explains, however, that the "cluster and services within it make the necessary minimum setup for the session to be established, and thus no network addresses need to be exchanged between the users, thus retaining the anonymity of the users." U. S. Patent 6,564,261 to *Gudjonsson et al.* at column 3, lines 28-31 (emphasis added). "A main function is to provide users with a simple and secure way of establishing arbitrary communication sessions with other users or service." *Id.* at column 7, lines 38-41 (emphasis added). "In basic terms, aspects of the system/network act as a broker(s), and can broker communication services between two or more people." *Id.* at column 7, lines 52-53. "Referring to FIGS. 3-6, a function of the system/network is to provide the possibility for users 7 to establish arbitrary communication sessions with other users 7." *Gudjonsson's* principle of operation includes the "routing service, and thus the "routing service" cannot be considered "optional," as Examiner Lezak asserts.

5. Because No Reasonable Expectation of Success was Cited, the § 103 (a) *Prima Facie* Case for Obviousness Is Improper

The Examiner's *prima facie* case for obviousness is defective. The Examiner's *prima facie* case for obviousness must include "a reasonable expectation of success." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition). Here, however, the Examiner's *prima facie* case wholly fails to include any expectation of success. The Examiner, then, has failed to carry the burden, so the *prima facie* case for obviousness must

BS00099

U.S. Application No. 09/709,038 Examiner LEZAK, Arrienne, Art Unit 2143
Response to April 28, 2006 Office Action

fail. The Assignee thus respectfully asserts that the § 103 (a) rejection of claims 1, 3-4, 6-12, 14-29, and 31-47 should be removed.

6. There Can Be No Reasonable Expectation of Success, so the Pending Claims Cannot be Obvious

The proposed combination of *Gudjonsson* and *Armstrong* cannot support a reasonable expectation of success. Again, there must be a reasonable expectation of success when combining documents. See M.P.E.P. § 2143. Here, however, the Examiner's *prima facie* case can have no expectation of success. Because *Gudjonsson* utilizes a "routing service," one of ordinary skill in the art would not expect success when attempting to combine the teachings of *Gudjonsson* with the teachings of *Armstrong*. Because *Gudjonsson* "establish[es] a communication session with another user without knowledge of the client device ... being used by the other user," U. S. Patent 6,564,261 to *Gudjonsson et al.* at column 3, lines 51-58 (emphasis added), one would not expect success to modify *Gudjonsson* and *Armstrong* to "[present] the second user's presence information ... indicating the second user's presence at the plurality of contact devices," as independent claim 1 recites.

Moreover, one would not expect success when considering the features recited in independent claims 12, 24, 37, and 43. These claims all recite features selecting a contact address to which a communication is destined. Independent claim 37, for example, recites "receiving the communication from the sender, wherein the communication indicates a contact address selected by the sender to which the communication is sent." Independent claim 37 also recites "sending the communication to a destination, wherein the destination of the communication is the contact address selected by the sender." Again, because *Gudjonsson* utilizes a "routing service" that automatically establishes a "rendezvous" between users, this routing service completely determines where a communication is delivered. As *Gudjonsson* explains, invitations "are not sent directly between users." *Id.* at column 3, lines 16-17 (emphasis added). "Instead, the routing service for the sending/inviting user sends the invitation to the routing service for the receiving user." *Id.* at column 3, lines 17-19. "The

BS00099

U.S. Application No. 09/709,038 Examiner LEZAK, Arrienne, Art Unit 2143
Response to April 28, 2006 Office Action

routing service for the [recipient] determines, according to a logic specified by the same [recipient], how the request is handled and what services are available to handle the request." *Id.* at column 3, lines 19-22. "Thus, the network enables any of the above communication services between users, and the initiating user need not know whether the other user is currently online via his/her PC or may instead be reached via pager or mobile phone." *Id.* at column 3, lines 58-63 (emphasis added). *Gudjonsson's* "routing service" thus "hides the messy details on how to locate and reach a given person/user at any given time." *Id.* at column 13, lines 49-50 (emphasis added).

One of ordinary skill in the art, then, would not expect success when attempting to combine *Gudjonsson* with *Armstrong* to obviate the pending claims. All the independent claims recite features for allowing the sender to select a contact address to which a communication is destined. The combined teaching of *Gudjonsson* and *Armstrong*, however, teaches that "no network addresses need to be exchanged between the users," thus retaining the anonymity of the users." U. S. Patent 6,564,261 to *Gudjonsson et al.* at column 3, lines 28-31 (emphasis added). Because *Gudjonsson* utilizes this "routing service," one of ordinary skill in the art would not expect success when combining *Gudjonsson* with *Armstrong*. The *prima facie* case for obviousness must fail, so the § 103 (a) rejection of the pending claims should be removed.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or scott@wzpatents.com.

Respectfully submitted,



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page 21